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IN THE SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1978
NO. 78-1304

AMERICAN SEATING COMPANY,
Petitioner,

v.

NATIONAL SEATING COMPANY,
Respondent,

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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IN THE SUPREME COURT OF THE UNITED STATES

October Term, 1978

NO.

AMERICAN SEATING COMPANY,
Petitioner,

v.

NATIONAL SEATING COMPANY,
Respondent,

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit entered in the above case on September 15, 1978, holding United States Patent 3,729,226 (A 30) invalid.

OPINIONS BELOW

The reported opinion holding United States Patent 3,729,226 invalid and not infringed was entered September 30, 1976, by the United States District Court for the Northern District of Ohio, Eastern Division and published at 457 F.Supp. 444 (A 1).

The reported opinion of the United States Court of Appeals for the Sixth Circuit affirming the invalidity of the United States Patent 3,729,226 ('226) and holding it was unnecessary to reach the other issues raised by the appeal was entered on September 15, 1978, and published at 586 F.2d 611 (A 18).

JURISDICTION

Petitioner seeks review of the Sixth Circuit Opinion dated September 15, 1978, for which a Petition for Rehearing was denied and entered on November 24, 1978. Jurisdiction is conferred on this Court by 28 U.S.C. 1254(1).

FEDERAL QUESTIONS PRESENTED FOR REVIEW

The following questions of law presented by this case have substantial impact and far reaching effect on the United States Patent Laws:

1. WHETHER A PRIOR ART DEVICE WHICH IS SUBSTANTIALLY DIFFERENT IN STRUCTURE BUT FUNCTIONALLY EQUIVALENT TO THE CLAIMED DEVICE OF A PATENT CAN BE AN ANTICIPATION UNDER 35 U.S.C.A. 102(b) SO AS TO INVALIDATE THE PATENT?

2. WHETHER THE COURTS IN DETERMINING THE VALIDITY OF A PATENT UNDER 35 U.S.C.A. 103 CAN DISREGARD EVIDENCE THAT THE DEVICE WAS UNOBVIOUS TO AN ACTUAL PERSON SKILLED IN THE ART BY REASON OF HIS NUMEROUS UNSUCCESSFUL ATTEMPTS TO DESIGN SUCH A DEVICE WITH ALL THE MOST PERTINENT PRIOR ART BEFORE HIM?

3. WHETHER IN THE FACE OF HARD EVIDENCE OF THE FACT THAT A PATENTED COMBINATION WAS UNOBVIOUS TO AN ACTUAL PERSON SKILLED IN THE ART, THE COURT CAN NEVERTHELESS HOLD A PATENT TO SUCH A COMBINATION INVALID BECAUSE IT DOES NOT PROVIDE A SYNERGISTIC EFFECT?

4. WHETHER A PATENT, THE DISCLOSURE OF WHICH IS SUFFICIENTLY CLEAR FOR ANYONE WITH AN ENGINEERING BACKGROUND TO CONSTRUCT, CAN BE HELD INVALID UNDER 35 U.S.C.A. 112 FOR FAILURE TO DESCRIBE PARTICULARLY THAT WHICH IS CLAIMED TO BE INVENTED MERELY BECAUSE THE PATENTEE CONTENDS THAT THE PATENTED DEVICE HAS INHERENT FUNCTIONS NOT REFERRED TO OR CLAIMED IN THE PATENT?

STATUTES INVOLVED

35 U.S.C.A. 102(b), at page 445:

§102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or . . . .

35 U.S.C.A. 103, at page 715:

§103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C.A. 112, at page 4:

§112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

STATEMENT OF THE CASE

This cause was originally tried under 28 U.S.C. 1338 on Petitioner American Seating's complaint that Respondent National Seating had flagrantly infringed its United States Letters Patent 3,729,226 (A 30) by copying Petitioner's highly successful tubular "inverted T" transit seat as installed in public transportation vehicles such as buses.

The District Court after a several day trial held the '226 patent invalid under (1) 35 U.S.C. 102, because it was antiticpated by the prior art, and (2) 35 U.S.C. 103, because it was obvious to those skilled in the art at the time of the invention. Petitioner appealed and the Sixth Circuit Court of Appeals affirmed the District Court. The Sixth Circuit also mistakenly held that the District Court had held the '226 patent invalid under 35 U.S.C. 112, because it failed to describe particularly that which was claimed to be invented.

The invention of the '226 patent is a meritorious transit seat having an inverted hollow tubular center T-pedestal that replaced and solved the problems of the conventional two-

legged aisle seats. Aisle leg seats throughout the years had created substantial problems which the industry, including the Petitioner and Respondent, attempted to solve with differently designed seats. In these attempts, Respondent designed a round-base, center-mounted seat, the "Tour Coach" (A 34) and Petitioner designed a similar round base seat being known as "American's Round Base." Both of these were unsuccessful. Respondent also designed over a period of two years, during the search for a workable seat to replace the aisle leg seats, several center pedestals PX65, PX66AA, PX69, (A 34) all of which were abandoned. PX69 is almost identical to a cast base constructed earlier for perimeter seating in a vehicle known as the Plane-Mate for transporting airline passengers from the terminal to the airplane (see A 35). Thus, such structures were well known to Respondent and its designer, Edwards, who the Court held was a person skilled in the art. Further, Edwards during all this time had knowledge of a tubular inverted T pedestal on a so-called Mitchell table (A 34). Despite his knowledge of all of these pedestals (see A 34) during his abortive efforts to design a seat to solve the problems of the aisle leg seats, Edwards, who was held by the District Court to be a person skilled in the art, failed to conceive of the '226 invention. It was not until September, 1972 (A 36), a substantial amount of time after early 1971, the date American's invention had been on the market (A 37), that National offered its accused design to the trade. The original design of the National pedestal was a dead copy of American's (compare A 38 and 39). Subsequently, changes were made in an attempt to avoid infringement.

The District Court held and the Sixth Circuit affirmed that the '226 patent was anticipated under 35 U.S.C. 102 by the previous round base seats of National and American despite the fact that a perfunctory comparison of the two disclosed a substantial and significant difference in their pedestal structures (A 40). It held that anticipation was made out because the prior art and the '226 invention were "functionally equivalent." Petitioner contends that such a holding is clearly erroneous as a matter of law.

The District Court also held and the Sixth Circuit affirmed that the '226 patent fails to provide the requisite synergistic effect needed by combination patents for validity under 35 U.S.C. 103. The Sixth Circuit confirmed the fact that the District Court did not consider the evidence involved in Edwards' abortive attempts to design a seat along with his knowledge of the prior art and the subsequent copying by National of the '226 invention. The Sixth Circuit held that it could not find reversible error in the District Court's failure to consider such evidence. Petitioner contends that such a holding is also clearly erroneous as a matter of law.

Because of the errors of law committed by the Sixth Circuit, Petitioner petitions for writ of certiorari. If this erroneous decision is left to stand, the entire law on anticipation and obviousness-unobviousness will be put in turmoil.

ARGUMENT

I. THE SIXTH CIRCUIT DECISION ON ANTICIPATION IS IN CONFLICT WITH ITS CONCURRENT *NICKOLA* V. *PETERSON* DECISION (A 41), THE DECISIONS OF OTHER CIRCUITS, AND THE PATENT STATUTE, AND THEREFORE THE LAW ON ANTICIPATION IS IN STATE OF CONFUSION UNTIL THE SIXTH CIRCUIT DECISION IS REVERSED.

A. Structural Identity, Not Functional Equivalency, Is The Test For Anticipation Under Section 102.

It has been firmly established that distinction should be made between the tests for validity under Sections 102 and 103.

The first test for validity under Section 102 is commonly referred to as the test for novelty or anticipation, i.e., whether or not a single prior art reference discloses all the identical elements of the structure defined by the claims of the patent. As stated by *General Tire & Rubber Co.* v

Firestone Tire & Rubber Co., 349 F.Supp. 345, 356 (N.D. Ohio 1972):

> . . . anticipation cannot be found unless all the elements of the invention are disclosed in a single prior art reference. *Firestone* v *Aluminum Co. of America*, 285 F.2d 928, 929-30, (6th Cir. 1960); *H. K. Porter Co., Inc.* v *Goodyear Tire & Rubber Co.*, 163 USPQ 106, 114-15 (N.D. Ohio 1969), aff'd 168 USPQ 449 (6th Cir. 1971); *Preformed Line Products Co.* v *Fanner Mfg. Co.*, 328 F.2d 265, 271, (6th Cir. 1964).

This maxim is specifically reinforced by the first clause of the second test under Section 103 which provides that:

> A patent may not be obtained though the invention is not *identically disclosed or described* as set forth in Section 102 of this title. . . . [Emphasis added.]

Section 103 then sets forth the test of whether the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

It is therefore very clear that the statute requires the sequence of the tests be first Section 102 and then Section 103. *Nickola* v *Peterson*, 580 F.2d 898, 909 (6th Cir. 1978).

Although the Sixth Circuit in this case applied Sections 102 and 103 in proper sequence, it improperly interpreted such sections so as to produce extreme confusion as to what the Patent Laws require for a valid conbination patent.

After finding significant differences in structure, the Sixth Circuit in the present case held that for anticipation the prior art need only disclose the function and manner of function of the patented device. In other words, the prior art need only be *functionally equivalent* and need not disclose the precise combination of structural elements recited in the

claims. In making this finding the Court at pages 618-619 (A 25-26) held as follows:

> The only significant difference between the seat disclosed by the '226 patent and the round base seats, relates to the shape of the pedestal feet. There is no difference in either the function performed by the tubular inverted "T" pedestal and the round-based pedestal, or in the manner in which the two types of pedestals perform their function. Thus the District Court's finding that the pedestals are equivalents is not clearly erroneous.
>
> In our opinion the District Court's determination that the '226 patent was invalid because it was anticipated, is correct.

This holding of the Circuit Court is directly in conflict with the holding of other Circuits and the Court of Claims. *Tights Inc.* v. *Acme-McCrary Corp.*, 541 F.2d 1047, 1056 (4th Cir. 1976); *Saf-Gard Products, Inc.* v. *Service Parts, Inc.*, 532 F.2d 1266, 1270 (9th Cir. 1976); *Tate Engineering, Inc.* v. *United States*, 477 F.2d 1336 (Ct.Cl. 1973); *Ling-Temco-Vought, Inc.* v. *Kollsman Instrument Corp.*, 372 F.2d 263, 267 (2nd Cir. 1967); *Illinois Tool Works, Inc.* v. *Sweethart Plastics, Inc.*, 436 F.2d 1180, 1182 (7th Cir. 1971). It also conflicts with the almost concurrent Sixth Circuit case of *Nickola* v. *Peterson, supra,* decided four days after the appeal hearing of the present case.

Petitioner contends that Section 102 as well as Section 103 of the Laws are to be interpreted as set forth in the well reasoned and written decision of Judge Markey in *Nickola* v. *Peterson, supra,* and for the reasons as stated therein. In the *Nickola* decision, Judge Markey, a visiting judge from the Court of Customs and Patent Appeals, and a noted jurist and lawyer of outstanding experience and reputation in the Patent Laws, clearly analyzes the background and intended purposes of Sections 102 and 103 of the Patent Laws.

The *Nickola* decision in reversing a holding of "*anticipation*" because there was no evidence of novelty held at p. 907 (A 50) as follows:

> The no-evidence-of-novelty finding cannot stand in the absence of record evidence: (1) that the identical invention, i.e., the *precise combination* of structural elements recited in each claim, "was known or used by others in this country * * * before the invention thereof by [Nickola]" (§102(a)); or (2) that the identical invention recited in each claim was "in public use or on sale in this country, more than one year prior to the date of [Nickola's] application" (§102(b)). No such evidence is of record. [Emphasis added.]

In *Nickola,* the Court specifically overruled a holding of anticipation because the District Court had done exactly what the Circuit Court in this case has done, that is, find no novelty under 35 U.S.C. 102 because there was no new "*function.*" The Court at p. 908 (A 51) condemned this type of analysis as follows:

> The *function* of the combination can be material, *not* on the novelty issue, but on the separate and distinct issue of nonobviousness (35 U.S.C. §103, supra note 9). [Emphasis added.]

The Court then went on to explain at page 908 (A 51) that a new result or function was not necessary for there to be novelty under § 102. In making this explanation it stated as follows:

> . . . The distinction [between novelty and function] is important, for patent law is entirely statutory and *there is not a word in the statute requiring a new result or a new function as a condition of patentability.* Indeed, a requirement that the result must itself be novel would nullify the statutory provision encouraging disclosures of "new and useful improvements thereof." 35 U.S.C. §101.

> Most patents are granted on improvements of prior devices; and the improved device will inherently achieve the same basic result as that achieved, and *will perform the same basic function as that performed, by the prior device.* [Emphasis added.]
>
> The Court then continued on page 911 as follows:
>
> . . . The invention is either new and useful or it is not. The amount of newness and usefulness need be only *minuscule* to avoid a finding of lack of novelty. That *minuscule* difference may or may not indicate that the invention as a whole would have been obvious, but it cannot indicate that the invention was old at the time it was made. So here, a minuscule difference, adding a gas meter, made Nickola's combination novel. [Emphasis added.]

A perfunctory comparison of the round base pedestal and the tubular inverted "T" pedestal of the '226 patent (A 40) discloses indeed, as stated by the Sixth Circuit at p. 617, that there is a significant difference between the pedestals of the seat disclosed by the '226 patent and the round base seat (A 24). Therefore, despite the fact that they may *function* substantially the same, the patented seat is *novel* and the patent issued thereon cannot under any circumstances be considered anticipated under Section 102 by the round base pedestal seats. Such a conclusion is not only strongly supported by *Nickola* v. *Peterson, supra,* but is supported by the facts and holdings of many other previous Sixth Circuit decisions, *Tee-Pak* v. *St. Regis Paper Co.*, 491 F.2d 1193, 1197 (6th Cir. 1974) (publications did not explicitly disclose the invention); *Monroe Auto Equipment Co.* v. *Heckethorn Mfg. & Sup. Co.*, 332 F.2d 406, 414 (6th Cir. 1964) (Court said anticipation belongs only with novelty); *Preformed Line Products Co.* v. *Fanner Mfg. Co.*, 328 F.2d 265, 271 (6th Cir. 1964) (prior art was distinguished from basic structure of patent) and decisions from other circuits. *Tights Inc.* v. *Acme-McCrary Corp., supra; Saf-Gard Products, Inc.* v. *Service Parts, Inc., supra; Tate Engineering, Inc.* v. *United States, supra; Ling-Temco-Vought, Inc.* v. *Kollsman Instrument Corp., supra; Illinois Tool Works, Inc.* v. *Sweethart Plastics, Inc., supra.*

Although the Court cited some of the above decisions in support of its holding of anticipation, all such decisions cited either found the prior art structure to be identical to the patented structure, or found that there was no anticipation in which event the obviousness-nonobviousness issue of Section 103 was then considered. Therefore, despite the use of the phrase in these cases that "all the elements of the invention or their equivalents be found," the cases provide no definition for what is meant by "or their equivalents." Further, none of the cases cited held that "functional equivalency" constitutes an anticipation. To the contrary, the *Nickola* decision at p. 908 (A 51) very succinctly sets forth the logical rationale that merely because a patented combination is "*functionally equivalent*" to the prior art does not make it structurally alike as is necessary for a holding of anticipation.

Therefore, it is respectfully requested that this Court review the holding of the Sixth Circuit on the issue of anticipation in order to eliminate the confusion created by the present decision and the cases which by dicta provide that anticipation is found if "all the elements *or their equivalents*" are found in a single prior art device or description.

II. IN DETERMINING THE VALIDITY OF A PATENT WHICH IS NOT ANTICIPATED BY THE PRIOR ART, THE COURTS IN DETERMINING OBVIOUSNESS-UNOBVIOUSNESS CANNOT DISREGARD EVIDENCE THAT THE DEVICE WAS ACTUALLY UNOBVIOUS TO ONE SKILLED IN THE ART.

As succinctly stated by the *Nickola* decision (p. 909) (A 52), "... novelty alone will not render an invention patentable. Some new and useful inventions are patentable. Some are not. To be patentable a new and useful invention must meet the third requirement—nonobviousness—set forth in 35 U.S.C. §103."

This "statutory formulation," *Graham* v. *John Deere Co.*, 383 U.S. 1, 12, 86 S.Ct. 684, 691 (1966), was enacted by Congress in 1952 to alleviate the difficulty in defining "invention." As noted by the Sixth Circuit in *Nickola* v. *Peterson, supra*, at p. 909, Footnote 20:

> ... Difficulties since 1952 have centered on inapt references to old cases calling on courts to find "invention," and on judicial efforts to supply semantic mechanisms as aids in defining "obviousness." Because inventions differ so widely, application of all such mechanisms to all inventions, as rules of law, would risk destruction of the entire statutory scheme. See note 22, *infra*. Exercise of the judicial process, in determining whether an invention has met the nonobviousness requirement, turns on application of the entire statutory provision, 35 U.S.C. § 103, to all relevant evidence of record.

The Sixth Circuit in the present case suffered the difficulties referred to in its own above quote. It incorrectly latched on to a "semantic mechanism" to define "obviousness" when it held at p. 621 (A 28):

> We agree with the District Court's conclusion that the '226 patent fails to provide the requisite synergistic effect needed by combination patents, for validity.

Further, it erred as a matter of law when it disregarded evidence of actual unobviousness by an actual person skilled in the art at the time the invention was made by stating at p. 622 (A 29):

> The District Court, in resolving the obviousness issue, did not consider and make findings with respect to American's contentions relating to (1) the long felt need for and commercial success of the '226 patent, (2) the failure of National to develop a viable center pedestal passenger bus seat, and (3) National's copying of the tubular inverted "T" pedestal disclosed by the '226 patent, within a short period after American placed it on the market. We find no reversible error in the District Court's failure to take into account these secondary factors in reaching its decision on the question of obviousness in this case.

This holding of the Sixth Circuit on September 15, 1978, is a complete contradiction of its own decision on June 23, 1978, *Nickola* v. *Peterson, supra*, which requires the "*application of the entire statutory provision, 35 U.S.C. §103, to all relevant evidence of record.*" [Emphasis added.]

In discussing the so-called "secondary considerations" referred to in the Supreme Court decision of *Graham* v. *John Deere Co., supra*, Judge Markey in the *Nickola* case at page 911, Note 21, (A 54) stated:

> The adjective "secondary" could not have meant that determination of obviousness-nonobviousness can be made in disregard of step (5) considerations when they are present. Failure to consider all relevant evidence would be both unjust and unjudicious. Moreover, when a conclusion of nonobviousness is reached at step (4) there is no need to consider step (5). Hence, if it were *permissible* to reach a conclusion of obviousness without consideration of the evidence in step (5), the latter would *never* be considered. [Emphasis added.]

The decision then concluded at p. 915, Note 26 (A 58), after logically discussing the *Graham* case and 35 U.S.C. 103.

> When the issue is obviousness-nonobviousness, however, a determination that an invention would have been obvious should be made, as should the determination of any issue in any type of case, *only* after consideration of *all* relevant evidence, see note 21, supra. [Emphasis added.]

Clearly, in view of this *Nickola* decision, the requirement of the Sixth Circuit in June, 1978, is that all relevant evidence be used in determining the issue of obviousness-nonobviousness. This is in complete contradiction to the present appealed holding of the Sixth Circuit on September, 1978, which held that the District Court did not consider all the relevant evidence in making a determination of obviousness-nonobviousness and did not commit reversible error by such failure. The law on this issue is in flux and requires the Supreme Court to clarify the same.

The Sixth Circuit in the present case attempts to justify its disregard of the evidence of actual unobviousness by stating at p. 622 (A 29):

> Although in a close case secondary factors may tip the scales toward patent validity, they cannot save a patent from invalidity when, as in the case here, there is such a plain lack of invention, and obviousness is clear. *Graham* v. *John Deere Co., supra*, 383 U.S. at 35-36; *Kamei-Autokomfort* v. *Eurasian Automotive Prods.*, 553 F.2d 603, 606 (9th Cir.), *cert. denied*, 434 U.S. 860 (1977); *T. P. Labs., Inc.* v. *Huge*, 371 F.2d 231, 236 (7th Cir. 1966).

However, a review of the Supreme Court Decision in *Graham* v. *John Deere Co., supra*, at 86 S.Ct. 703, clearly establishes that all the relevant facts were considered by the Court because they "lend a helping hand to the judiciary," "serve to guard against slipping into use of hindsight," and "serve to resist the temptation to read into the prior art the teachings of the invention in issue." Specifically, the

Supreme Court considered the fact that the invention had eluded one skilled in the art who had long and unsuccessfully sought to solve the problem and it considered the long felt need in the industry. However, it held those facts did not "tip the scales of patentability" because the unsuccessful attempts of one skilled in the art were made before the teachings of the prior art patent reference became available to him. In other words, it held that at the time of the invention such person skilled in the art with the prior art patent before him would have obviously conceived of the patented device. Accordingly, *Graham* v *John Deere Co., supra*, did not hold that relevant facts need not be considered in determining obviousness-unobviousness but to the contrary, in applying Section 103 it considered all the relevant evidence of record. The Supreme Court should review this present case in order to clearly mandate that in making a decision on obviousness, all the relevant evidence should be considered.

The facts which the Court in this case has refused to consider do not relate to the issue of what would be obvious to a hypothetical person having skill in the art or what would be obvious to what *Nickola* v. *Peterson, supra*, p. 911, calls a "legal ghost." *They relate to what an actual person skilled in the art did not obviously do despite the fact he had knowledge of all the prior art.*

Specifically, the record, which the Court in the present case completely disregarded, establishes beyond any doubt that the Defendant before and after the present invention was conceived made extensive efforts to design a center pedestal seat which would replace the aisle leg seats and still have structural integrity and be sufficiently lightweight and of reasonable costs. Defendant's chief designer since 1951, Edwards, was instructed by his superiors in February or March, 1970, to design a center pedestal seat (A 59). During his unsuccessful attempts to design such a seat, *this designer*, which the District Court found at p. 455 (A 12) possessed skill "indicative of the level of ordinary skill in the

art" *was exposed to and had knowledge of all of the prior art relied upon by the Court in its holding of invalidity*. This art (A 34) included the prior art relied upon by the Sixth Circuit to invalidate the '226 patent, i.e., a round base transit seat, a tubular base pedestal used on the Mitchell table, elongated type of pedestal bases such as that shown by PX65, PX66AA, and a cast base almost identical to that of Heywood-Wakefield. All of these various bases were known by this person skilled in the art as he was being pressured by Defendant to develop a center pedestal seat. As testified to by Kastran, an officer of Defendant, bus drivers were constantly pressuring him to design a center pedestal seat (A 60).

> ". . .It was getting to be a hot and heavy subject." (A 60)

Although Edwards was instructed by his superiors in February or March, 1970, to design a center pedestal seat (A 59), it was not until after the subject invention was on the market that the accused design was adopted.* The abortive attempts of Defendant's skilled-in-the-art employee to develop a workable single pedestal seat, during which time he was armed with all the prior art relied upon by the District Court, is unusual evidence that unequivocally supports a holding of actual unobviousness. *Illinois Tool Works, Inc.* v. *Sweethart Plastics, Inc., supra*.

It is submitted the Court should review and reverse the present decision which conflicts not only with the Sixth Circuit's concurrent decision but also with the decisions of other Circuits.

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* October 12, 1972, was the earliest date that can be established by documentation (PX4E, A 61).

III. IN FACE OF THE FACTS THAT THE PATENTED SEAT WAS ACTUALLY UNOBVIOUS TO ONE SKILLED IN THE ART, IT WAS UNNECESSARY FOR THE COURT TO CONSIDER WHETHER THE CLAIMED COMBINATION PRODUCED A SYNERGISTIC EFFECT.

In *Nickola* v. *Peterson*, as previously stated, reference is made to "judicial efforts to supply semantic mechanisms as aids in defining 'obviousness.'" In regards to such "semantic mechanisms," the Court states as follows at p. 909 (A 52):

> . . .Because inventions differ so widely, application of all such [semantic] mechanisms to all inventions, as rules of law, would risk destruction of the entire statutory scheme.

The above statement applies to "semantic mechanisms" utilized by the Court in the present decision. Specifically, the requirement of a "synergistic effect or result" is the "semantic mechanism" utilized by the Court to support invalidity in the present case. The Court in effect used this so-called "semantic mechanism" as a substitute for considering all of the relevant evidence of nonobviousness discussed above.

Petitioner submits that once it is determined as a matter of fact that an actual person skilled in the art at the time of the invention had made unsuccessful attempts to design seats for the same use as the present invention, despite his knowledge at that time of all the prior art relied upon by the Court for invalidity, the use of any "semantic mechanisms" is unnecessary since unobviousness of the invention is conclusive.

It is submitted the Court should review the present decision since to let it stand leaves the entire law on obviousness-unobviousness in a state of flux and confusion.

IV. A PATENT WHICH INCLUDES A DISCLOSURE WHICH IS SUFFICIENT FOR ANYONE WITH AN ENGINEERING BACKGROUND TO CONSTRUCT, IS NOT INVALID UNDER 35 U.S.C.A. 112 FOR FAILURE TO DESCRIBE PARTICULARLY THAT WHICH IS CLAIMED TO BE INVENTED EVEN THOUGH THE PATENTEE PRESENTED EVIDENCE THAT THE PATENTED DEVICE HAS INHERENT FUNCTIONS NOT REFERRED TO OR CLAIMED IN THE PATENT.

Petitioner, during the course of the trial, introduced evidence to support the fact that the patented seat had certain inherent energy absorption and safety characteristics which were not referred to or claimed in the '226 patent. Petitioner does not base patentability on such characteristics but presented evidence concerning the same merely for the enlightenment of the Court. In response to this evidence of the inherent characteristics, contrary to what the Sixth Circuit contends in its decision on p. 613 (A 20), the District Court merely stated at p. 457 (A 14):

> Since the '226 patent is silent in regards to any feature of energy absorption or safety features, such considerations cannot be considered by this Court. *If* plaintiff bases patentability of its patent on these features, the patent is invalid as failing to particularly point out and distinctly claim that which it alleges is the subject matter of its patent pursuant to Title 35 U.S.C. §112. [Emphasis added.]

In view of this holding and Petitioner's disclaimer of basing any patentability on such characteristics, the issue of validity under Section 112 should be moot. Nevertheless, the Sixth Circuit held the patent to be invalid "because it failed to describe particularly that which was claimed to be invented under 35 U.S.C. 112." In making such a holding, there is no explanation or reasons for the same in the decision. Therefore, it is very confusing. Whatever may be the reason, such holding is in error as a matter of law.

The holding is very confusing because Section 112 contains no language to the effect that a patent must "describe particularly that which is claimed to be invented." Even if it could be interpreted as requiring in the first paragraph of Section 112 that the description must describe that which is in the claims, since the record clearly establishes the claims are silent in regards to energy absorption or safety features, the description need not mention the same.

The first paragraph of Section 112 requires the specification to contain a "written description . . . in such full, clear, concise and exact terms as to enable any person skilled in the art . . . to make and use the same, ..."

The record clearly establishes that the written description of the invention is full, clear, concise and exact so that one skilled in the art can construct it. Specifically, Edwards, testified as follows (A 62-63):

> Q Have you read the Barecki Patent which is involved in this present suit?
> A I have gone through it, yes.
> Q Do you think you could make a seat like that from that description?
> A I don't see why not. Anybody could, with any background, engineering background could.

Therefore, the first paragraph of Section 112 is satisfied as a matter of fact and law. As stated in *Tillotson Mfg. Co. v. Textron, Inc., Homelite*, 337 F.2d 833, 840 (6th Cir. 1964), "the test is whether the disclosures make the invention clear to a mechanic skilled in the art so that he could construct the carburetor and use it."

The second paragraph of Section 112 does not apply to the Sixth Circuit holding. It requires that the specification shall conclude with "claims particularly pointing out and distinctly claiming" the invention whereas the invalidity holding is based on failure "to describe particularly that which was claimed."

CONCLUSION

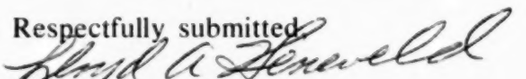
The Sixth Circuit Court of Appeals, by affirming the decision of the District Court on the Patent Law issues of "anticipation" under Section 102 and "obviousness" under Section 103 has placed the law on these issues in a state of flux and confusion and has created a conflict not only within its own circuit but between the circuits, the other federal courts, and with prior decisions of the United States Supreme Court.

The test for anticipation is clearly a question of novelty, that is, whether or not a single prior art reference discloses the precise combination of elements recited in the claims. Functional equivalency of the elements is not sufficient to negate novelty. Once it is determined that anticipation is lacking, the question is one of "obviousness-unobviousness," that is, whether the differences between the prior art and the subject matter sought to be patented are such that the subject matter as a whole would have been obvious to one skilled in the art at the time the invention was made. The determination of the question of "obviousness-unobviousness" should be made only after consideration of all relevant evidence. If after considering all relevant evidence, a determination is made that as a matter of fact the invention was not obvious to an actual person skilled in the art, all "semantic mechanisms" such as whether a combination gives a "synergistic effect or result" should be ignored. Neither should such "semantic mechanisms" be used as a substitute for considering all the relevant evidence on unobviousness.

The Sixth Circuit in this action did not follow the above in reaching a decision on validity and, as a result, committed reversible error. Further, its decision holding the patent in suit invalid for failure to comply with Section 112, is in error as a matter of law. Therefore, a review by the United States Supreme Court will lead to a reversal of the Sixth Circuit Court of Appeals in the present case.

Because the issues under Sections 102 and 103 arise frequently, both in the United States Patent and Trademark Office and in the courts, its review by the United States Supreme Court is imperative. Therefore, writ of certiorari to the Sixth Circuit Court of Appeals is respectfully solicited.

Respectfully submitted,



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